

Remarks/Arguments

The present Amendment is made in response to the Office Action dated November 1, 2005, and identified as Paper No. 10192005. Claims 1-12 remain pending in the application.

In the Action, the Examiner objected to the drawings because a reference numeral was unclear and not mentioned in the specification. The Examiner objected to claim 1 as including an acronym. The Examiner rejected claims 1-3, 5-6, 8-10, and 12 as unpatentable under 35 U.S.C. § 103 as obvious over U.S. Patent No. 6,937,454 to Mikolajczak et al. ("*Mikolajczak*") in view of U.S. Patent No. 6,101,076 to Tsai et al. ("*Tsai*"). Claims 4 and 11 were rejected as unpatentable under 35 U.S.C. § 103 as obvious over *Mikolajczak* and *Tsai* in further view of U.S. Patent No. 4,571,656 to Ruckman ("*Ruckman*"). Claim 7 was rejected as unpatentable under 35 U.S.C. § 103 as obvious over *Mikolajczak* and *Tsai* in further view of U.S. Patent No. 6,452,269 to Ohbayashi ("*Ohbayashi*") and U.S. Patent No. 5,956,158 to Pinzarrone et al. ("*Pinzarrone*").

I. Objection to Drawings

Applicant has submitted amended drawings complying with the Examiner's request for formal drawings. Applicant has also amended the specification to correct a typographical error in the reference to numeral 38 of Fig. 1.

II. Claim Objections

Claim 1 has been amended to include the meaning of the acronym "EMC."

III. Rejection of Claims 1-7

With regard to the rejections of claims 1-7, the modification of *Mikolajczak* according to *Tsai* that proposed by the Examiner in order to reject all of the claims of the present application fails to present a *prima facie* case of obviousness under 35 U.S.C. § 103 for several reasons. In

particular, the prior art does not disclose all of the elements of the invention now recited in claims 1-7, nor does the prior art suggest or motivate the claimed invention.

First, the proposed modifications to *Mikolajczak* do not disclose each and every limitation recited in the claims. Claim 1 recites that the ground line is AC coupled to the power line outside the ferrite choke “and routed through high impedance.” See Fig. 1 (resistor 20). *Mikolajczak* does not disclose any coupling of the ground line and *Tsai* discloses capacitive coupling of the ground line to a power line prior to either line passing through the EMC circuitry. Thus, even if *Mikolajczak* could be modified according to *Tsai*, the resulting device would not include a ground line AC coupled to the power line outside a ferrite choke and routed through high impedance.

Second, the modifications to *Mikolajczak* are not properly suggested or motivated by the prior art. As explained by the Federal Circuit in *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the ***desirability of making the specific combination*** that was made by the applicant. (internal citations omitted) (emphasis added)

The Examiner has not pointed to any motivation for the making the combination recited by Applicant. The suggestion relied on by the Examiner is that the “inclusion of inductances and capacitors provide filtering of unwanted noises and overvoltages.” While this statement alone may be true, this general principle does not suggest modifying *Mikolajczak* to have the data lines and the ground line pass through a ferrite choke as presently recited in the claims because it fails

to suggest the desirability of making the specific combination as required under *In re Kotzab*.

Similarly, the motivation does not suggest AC coupling the ground and power lines after the ground line passes through the choke. Accordingly, the proposed motivation is insufficient to suggest the claimed invention.

Finally, *Tsai* does not provide the requisite motivation to modify *Mikolajczak* as proposed by the Examiner. *Tsai* discloses that a **complete LC circuit** may be used to reduce EMC interference, not a ferrite choke, as the ground line is supplied to a **bead inductor** as part of the LC circuit. *Tsai*, col. 2, lines 32-52. A bead inductor is not a ferrite choke. *Tsai* thus fails to suggest a ground line that passes through “a choke comprising a ferrite core” (as claimed in the present application) and, more importantly, *Tsai* fails to suggest that a ground line should pass through a ferrite choke **along with the data lines** (as further claimed in the present application). *Tsai* also fails to suggest AC coupling the ground and power lines and routing the power line through high impedance. Thus, *Tsai* does not in fact motivate the claimed invention as required for a proper obviousness rejection.

As claims 2-7 depend from claim 1, they are also patentable over the cited references.

IV. Rejection of Claims 8-12

The prior art does not disclose each and every element of the invention now recited in claims 8-12 as required for a rejection under 35 U.S.C. § 103(a). Claim 8, as amended, requires that the separate signal lines of a single channel that are interconnected to the controller, i.e., D+, D-, and 5V, as well as a fourth signal line (GND), all pass through the claimed ferrite choke. *Mikolajczak* only discloses that two signal lines (D+ and D-) pass through the choke for any single USB channel (*Mikolajczak* is directed at ways of combining multiple channels with EMC circuitry). While *Mikolajczak* discloses multiple signal lines, they are repetitive lines (D+, D-,

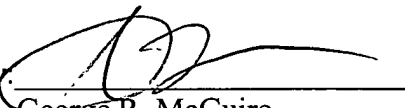
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D+, D-) of multiple channels rather than the claimed *single* channel of the present invention. As claims 9-12 depend from claim 8, they are also patentable over the cited references.

In view of the foregoing amendments, the Examiner's consideration is requested and allowance of the present application is believed to be in order. If the Examiner believes a phone conference with Applicant's attorney would expedite prosecution of this application, please contact the undersigned at (315) 218-8515.

Respectfully submitted,

Dated: February 1, 2006

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Amendments to the Drawings

The attached sheets of drawings includes changes to Fig. 1 and 2. These sheets, which include Figs. 1 and 2, replace the original sheets including Figs. 1 and 2. The drawing figures have been amended to clearly show the reference numeral at the bottom of Fig. 1 and comply with regulations regarding formal drawings.

Attachments: Replacement Sheets (2)
Annotated Sheet Showing Changes (2)

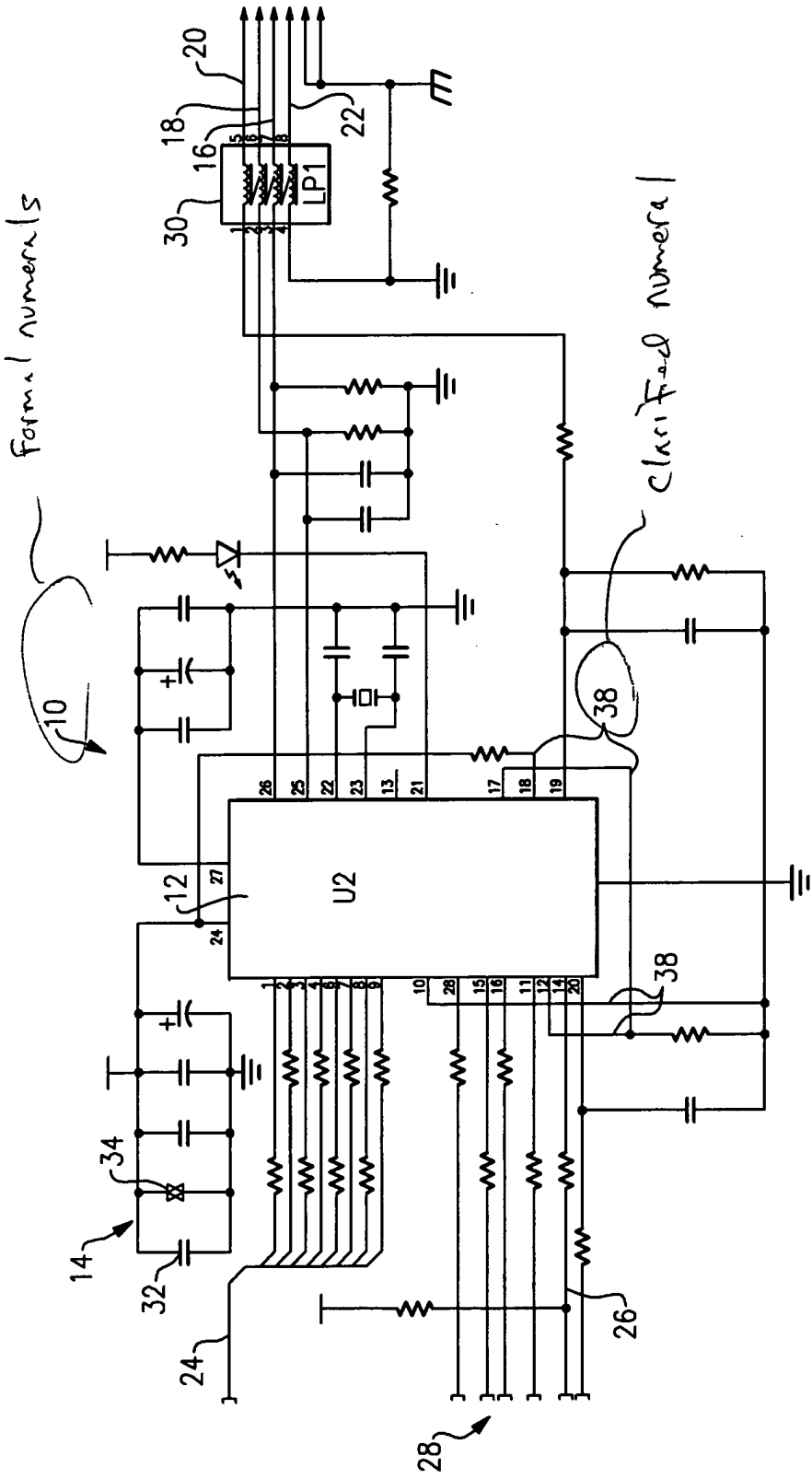


FIG.1

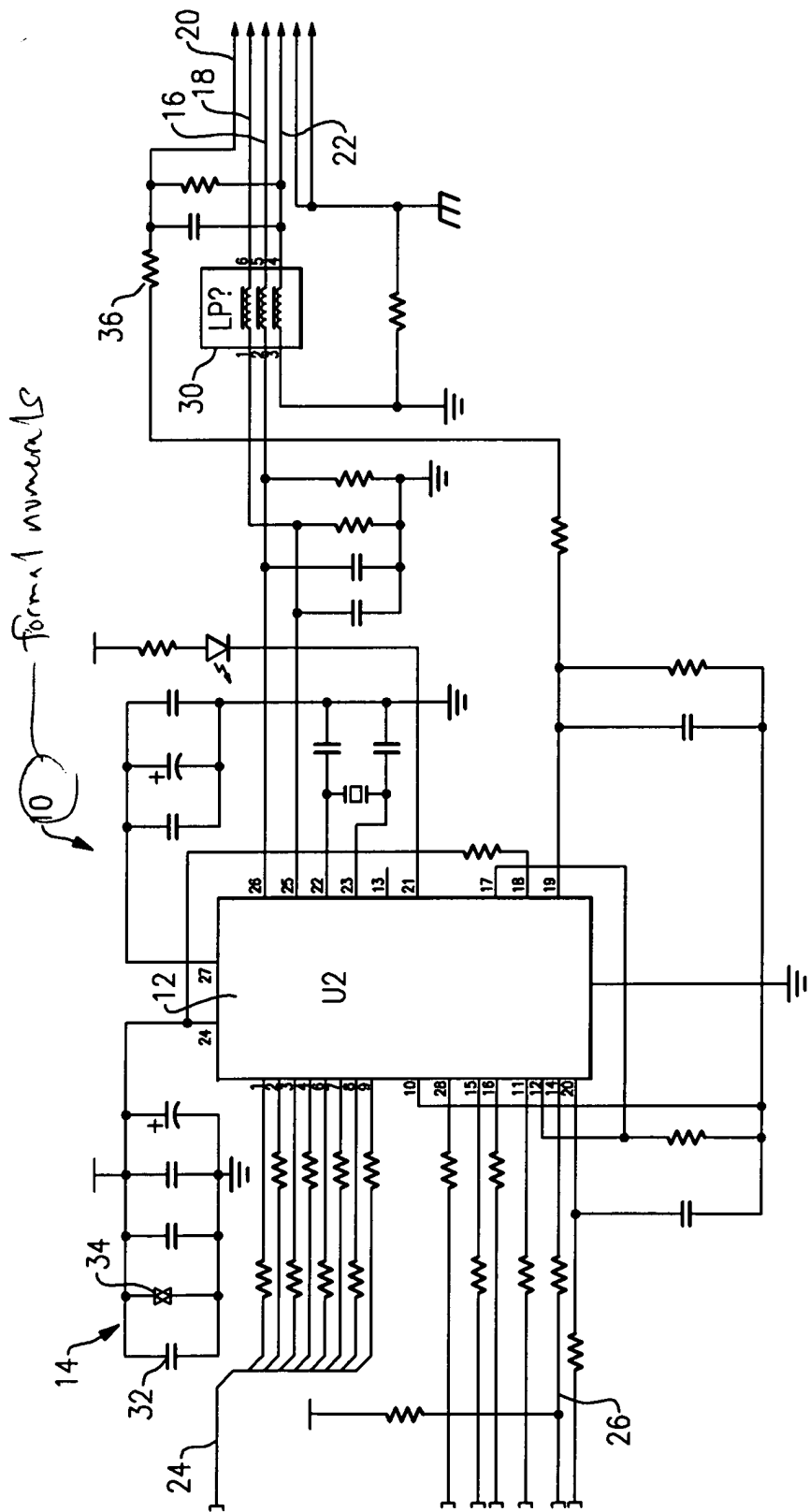


FIG. 2